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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/039,175 | 12/31/2001 | Michael Leon Feilmeier | 80252-0183 | 7161 |
| 20480 | 7590 | 09/30/2004 | EXAMINER | |
| STEVEN L. NICHOLS RADER, FISHMAN & GRAVER PLLC 10653 S. RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095 | | | PAPPAS, PETER | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2671 | | |
| DATE MAILED: 09/30/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|------------------------|---------------------|--|
| Advisory Action | Application No. | Applicant(s) | |
| | 10/039,175 | FEILMEIER ET AL. | |
| | Examiner | Art Unit | |
| | Peter-Anthony Pappas | 2671 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 13 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on 09 September 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-15, 17, 18, 20-25, 27-30, 34-39 and 41-43.

Claim(s) withdrawn from consideration: _____.

8. The drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. Other: _____.



MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Continuation of 5. does NOT place the application in condition for allowance because: In response to applicant's remarks in regards to claims 1, 25 and 34 it is noted the respective preambles for said claims are considered open ended, because of the use of the word "comprising." Said claim language allows, for example, a second memory or second memory location within the original memory. In addition said claim language does not exclude the storing of an initial contact point in said second memory or within a second location within said original memory. Thus, applicant's remarks are deemed unpersuasive.

In response to applicant's remarks in regards to claims 3, 4 and 39 Kung et al. (U.S. Patent No. 6, 570, 583) teaches pointing device 104 is a 2D rocking switch. However, a pressure-sensitive switch (not shown) is disposed under the central portion 106 of the rocking switch 104. A user may rock the switch 104 left, right, up or down (rotary direction) without necessarily activating the pressure sensitive switch. However, by directing a firm enough force on the central portion 106 (linear direction) of the rocking switch 104, the pressure-sensitive switch can be activated (column 5, lines 53-57, and column 6, lines 1-14). Thus, applicant's remarks are deemed unpersuasive.

In response to applicant's remarks in regards to claim 13 Echerer et al. (U.S. Patent No. 5, 384, 862) teaches a bitmap is stored in such a way that changes are inhibited and then displayed on a high resolution monitor. The image displayed is processed, wherein said processing enhances the image displayed and extracts information from the image as a result of an interchange of instructions and responses between CPU and user. The enhancements and information are stored in a second memory location, separate from the bitmap. A report is prepared using the information and the image together with its enhancements and/or without them; the report is stored in a third memory location (column 6, lines 17-37).

Applicant discloses in the specification that "the original CAD file from block 304 and the converted CAD script from block 70, both in the native format, are then combined by playing the script file against the original CAD file at block 72... playing the script file against the original CAD file generates a modified CAD file in the native format at block 84" (page 7, lines 1-3). Thus, applicant discloses an original data element (bitmap) and a secondary data element (enhancements and information), wherein said secondary data element is stored separate from said original data element, are operated on in tandem to generate a third separate data element (report).

Furthermore applicant fails to teach the details of the script file format and thus giving the broadest reasonable interpretation to said claim language said claim language could be interpreted as reading on added text and overlaying said text with an image, wherein said combination is represented by a separate element from those of the first two elements.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Thus, applicant's remarks are deemed unpersuasive.